

REMARKS/ARGUMENTS

The non-final Office Action dated 3/10/2005 rejected claims 1-13, 26, 27, 33 and 35. Claim 14, 25 and 28-32 were withdrawn from consideration pursuant to a restriction requirement. By this Amendment, claims 1, 4, 11, 13, 26, 27, 29 and 33 are amended. Claim 34 was cancelled. New claims 36 and 37 reciting a pharmaceutical composition are presented. Claims 1-13, 26-27, 33 and 35-37 are pending and under examination.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow claims 1 -13, 26, 27, 33 and 35 - 37 and pass this application to issue.

Amendments to the Specification

The specification was objected to due to the inadvertent omission of Greek letters, e.g. " __g/." Also, a date of "19XX" was in need of correction.

By the present amendment, applicants have reviewed the specification as filed in the USPTO and corrected all cases where printing errors resulted in the omission of Greek letters. Support for the corrections may be found in the companion application, Ser. No. 10/612,885.

New Claims 36 and 37

Claims 26, 27 and new claims 36 and 37 are directed to pharmaceutical compositions, consistent with the election of Group I. The pharmacologically effective amount finds support in paragraph [000114]. Otherwise, the claims find support in the definitions found in the original claims. It was an oversight to include the combination in the pharmaceutical composition, as the combination would be unlikely to be used. Rather, it is the small organic compound that finds use. While some of these compounds are not novel, there is no evidence that they were ever found to be pharmacologically active and

formulated in a pharmaceutical composition in an amount to modulate EPO-R activity. As the Official Action states, the references uncovered "...do not teach or suggest, alone or in combination, any of the instantly claimed compounds of formulae (1) – (4) in combination with EPOR."

Turning now to the Detailed Action, the following remarks are set forth and responded to in the same order as presented in the Office Action.

Election/Restriction

Applicants have elected Group I with traverse. Accordingly, claims 14, 25, and 28-32 are withdrawn. Claims 1-13, 26, 27 33 and 35 were examined on the merits. The species of claim 35 was elected for examination.

On page 3 of the Official Action, the Examiner indicates that the combination of the polypeptide of the modulating sequence and the specifically specified (elected) compounds are free of the prior art, as well as the species of formulae (1), (2) and (3). . This combination is present in claims 1 – 13.

Claim Rejections – 35 USC §112

Claims 1-13, 26, 27, 33 and 35 were rejected as indefinite due to the lack of a chemical structure in section (4) of claim 1. Claim 1 now includes the formula for the diazolohehexahydroquinoline, so it should avoid the rejection.

Claim Rejections – 35 USC §101

Claims 1-13, 26, 27, 33 and 35 were rejected as directed to non-statutory subject matter.

These claims have been amended to exclude the presence of the combination in a human. The term "human" is found in paragraph [00030] as one of the species associated with the combination and can be specifically excluded from the species listed.

The claims to the combination, claims 1 – 13, exclude being present in humans. This avoids the rejection for non-statutory subject matter. Limiting to "isolated" or "purified" would be unduly limiting. The combination can find use in assays, where the combination will be formed in the assay. One need not isolate or purify the combination to allow for its use in assays, so the Examiner's kind suggestion has not been adopted.

Double Patenting

Claims 1-13, 26 and 27 were provisionally rejected under a same invention type of double patenting over claims 1-13, 16, and 17 of copending application Ser. No. 10/612,885. Claims 1-13, 26, 27, 33 and 35 were provisionally rejected under obviousness type double patenting over claims 1-13, 16, and 17 of copending application Ser. No. 10/612,885.

Double patenting is avoided by cancellation of the common claims in co-pending application 10/612,885, the amendment being filed 05/17/2005. That amendment cancels claims 1-13, 16, and 17 in that application. The Examiner is respectfully requested to withdraw this rejection.

CONCLUSION

The Examiner's meticulous consideration of the application is appreciated. This invention is a very important asset of the subject assignee and the assignee wishes to ensure that any claims that are issued have been thoroughly considered.

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow claims 1 -13, 26, 27, 33 and 35 -

37 and pass this application to issue, subject to resolution of the double patenting rejections and cancellation of withdrawn claims.

If the Examiner believes that the prosecution of the subject application may be expedited by a telephonic interview, the Examiner is hereby authorized to call Bertram Rowland collect at (650) 344-4674.

Finally, Applicants request that future correspondence be addressed to PETERS, VERNY, JONES, SCHMITT & ASTON, LLP, 425 Sherman Avenue, Suite 230, Palo Alto, CA 94306 in view of the Power of Attorney and Change of Correspondence Address filed January 5, 2005.

Respectfully submitted,

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